

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-11 and 13-23 are pending in the present application. No claims are amended by the present amendment, thus, no new matter is added.

In the outstanding Office Action, Claims 1-11 and 13-23 were rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement; Claims 1-11 and 13-23 were rejected under 35 U.S.C. §112, second paragraph as failing to set forth the subject matter which applicants regard as their invention; Claims 1-9, 11 and 13-23 were rejected under 35 U.S.C. §102(a) as anticipated by Matsushima (U.S. Pat. App. No. 2002/0054397); and Claim 10 was rejected under 35 U.S.C. §103(a) as unpatentable over Matsushima in view of Kimura (U.S. Pat. No. 6,226,097).

With respect to the rejection of Claims 1-11 and 13-23 under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement, Applicants respectfully traverse this rejection as improper.

The outstanding action asserts on page 5 that “this claimed subject matter does not enable one ordinary skilled in the art to conduct or perform the invention according to the specification...one skilled in the art does not know under what condition(s) an application launch part would access the launch selection part and adding application(s) to the image forming apparatus.” However, Applicants respectfully submit that this assertion misinterprets the requirements of the test for enablement.

Specifically, MPEP §2164.01 states, with regard to the test for enablement, that “any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information

regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.”

As is pointed out on page 5 of the outstanding Action, the first embodiment of the originally filed disclosure, for example, does provide a detailed explanation regarding the conditions under which the application launch part access the launch selection part and adds application to the image forming apparatus. The enablement requirement does not necessitate that the *claims* provide a sufficient description so as to enable one skilled in the pertinent art to make and use the claimed invention. Instead this requirement simply necessitates that one reasonably skilled in the art be able to make or use the invention from the originally disclosure coupled with information known in the art without undue experimentation. This requirement is clearly met in the present application.

In addition, MPEP §2164.01(a) states that

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.

In light of the above noted requirements, the enablement rejection made in the outstanding Action is improper as there is no discussion of factors (A)-(H) noted above in the rejection as is required by the MPEP.

With regard to the rejection of Claims 1-11 and 13-23 under 35 U.S.C. §112, second paragraph, as indefinite, Applicants respectfully traverse this rejection.

The outstanding Action states on page 6 that “evidence that claims 1, 22 and 23 fail to correspond in scope with that which applicant(s) regard as the invention can be found in the specification filed July 19, 2003.” The outstanding Action goes on to recite portions of the specification which supposedly support this assertion. However, MPEP §706.03(d) specifically indicates that this type of §112, second paragraph rejection cannot be based on description in the specification. In addition, MPEP §2172 states that

A rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

The outstanding action has not provided any evidence, other than the specification, that the invention recited in the claims is not what Applicants regard as their invention.

Therefore, Applicants respectfully request that the rejection of Claims 1-18 under 35 U.S.C. §101, 35 U.S.C. §112, first paragraph, and 35 U.S.C. §112, second paragraph, be withdrawn.

Addressing now the rejection of Claims 1-9, 11 and 13-23 under 35 U.S.C. §102(a) over Matsushima, that rejection is respectfully traversed.

Claim 1 recites

An image forming apparatus that includes service modules for performing system side processes on image formation, wherein applications can be added to the image

forming apparatus separately from the service modules, the image forming apparatus comprising:

an application launch part configured to access launch selection information, the launch selection information indicating at least a location of an auxiliary storage device that stores one or more applications, and configured to launch the one or more applications from the auxiliary storage device according to the accessed launch selection information,

wherein the service modules are stored in a memory distinct from the auxiliary storage device.

Claim 22 recites similar features and Claim 23 recites at least the above noted features.

Matsushima describes an image processing device that includes a CD-ROM 17, a CPU 11 and a HDD 15. In addition, Matsushima describes that the control program for the image processing device is installed to the HDD 15.

However, Matsushima does not describe or suggest an application launch part configured to access launch selection information, the launch selection information indicating at least a location of an auxiliary storage device that stores one or more applications, and configured to launch the one or more applications from the auxiliary storage device according to the accessed launch selection information, where the service modules are stored in a memory distinct from the auxiliary storage device, as is recited in Claim 1.

The outstanding Action states on page 8 that the auxiliary storage device recited in the claimed invention is equivalent to a computer on the network or a “network storage device” which is connected to the multifunction device 100 of Matsushima via the NCS 128. However, Applicants respectfully traverse this assertion and submit that the “network storage device” of Matsushima cannot be interpreted as being equivalent to the recited auxiliary storage device as the auxiliary storage device is recited as storing one or more applications which are launched from the auxiliary storage device.

The outstanding Action asserts that the “reprint application” of Matsushima is equivalent to the one or more applications stored in the auxiliary storage device, however, the

“reprint application” of Matsushima is not stored on or executed from a “network storage device.” Instead the “reprint application” is one of the applications 140 installed on the multifunction device 100.<sup>1</sup>

Nothing in Matsushima describes an application launch part which is configured to launch the one or more applications from an auxiliary storage device; this feature is simply not described or suggested in Matsushima.

Accordingly, in light of the above noted discussion, Applicants respectfully submit that Claim 1, and similarly Claims 22 and 23, patentably distinguish over Matsushima.

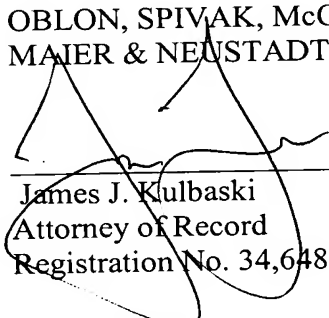
In addition, the further cited Kimura reference does not cure the above noted deficiencies of Matsushima with respect to the above noted features.

Accordingly, Applicants respectfully submit that Claims 1, 22 and 23, and claims depending therefrom, patentably distinguish over Matsushima and Kimura considered individually or in combination.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance.

Respectfully submitted,

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<sup>1</sup> See Matsushima, Figure 10.